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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/269,323	06/30/94	NIMITZ	J 2124001D

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12M1/0828

EXAMINER
ANTHONY, J

ART UNIT	PAPER NUMBER
1208	

DATE MAILED: 08/28/97

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 22

Application Number: 08/269,323

Filing Date: 06/30/94

Appellant(s): Jonathan S. Nimitz et al.

Holly D. Kozlowski

For Appellant

EXAMINER'S ANSWER

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This is in response to appellant's brief on appeal filed 07/14/97 as Paper Number 21.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 157-158, 160-167, 169-175, and 177-179 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

“The Technical Report” distributed by the Defense Technical Information Center of the Defense Logistics Agency, Alexandria, Va..

(10) *New Prior Art*

No new prior art has been applied in this examiner's answer.

(11) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 157-158, 160-167, 169-175, and 177-179 are rejected under 35 U.S.C. 103(a) as being obvious over “The Technical Report” distributed by the Defense Technical Information Center of the Defense Logistics Agency, Alexandria, Va.. This rejection is set forth in section 2 of the prior Office action, Paper No. 16.

(12) *New Ground of Rejection*

This examiner's answer does not contain any new ground of rejection.

(13) *Response to argument*

Applicants' main argument for patentability is that a specific lone statement of *The Technical Report*, as found in the bridging paragraph on pages 2 and 3 of the said *Technical*

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Report, and as transcribed on page 6 of Appellants' Appeal Brief, provides no motivation to one having ordinary skill in the art to formulate fire-extinguishing admixtures comprising a fluoroiodocarbon compound and an additive species selected from the group consisting of perfluorocarbons and hydrofluorocarbons. This position of applicants is wholly rejected by the Examiner. A reading of the entire *Technical Report* shows that binary mixtures of fire-extinguishing agents are disclosed as highly advantageous in many different fire extinguishing circumstances. Although *The Technical Report* does state that no generalization could be made regarding the choice of constituents used in the said mixture, such a statement is not deemed to teach or suggest away from applicants' claimed invention. In the first place, the examiner has provided sufficient motivation and support for the rejection of applicants' invention.

Secondly, applicants' assertion that *The Technical Report* fails to provide any overall motivation for the successful combination of binary mixtures of fluoroiodocarbons with either perfluorocarbons or hydrofluorocarbons, is given little weight for the following reasons: 1) There is no PER SE requirement in patent jurisprudence that the applied prior-art has to teach and/or directly suggest that the combination of two or more components will result in an improvement as compared to the use of the said components separately. Rather, it is only required that the applied prior-art motivate one having ordinary skill in the art to make the said combination whether the combination has superior or inferior properties as compared to its subcomponents., Furthermore, it is not necessary for a finding of *prima facie* obviousness that the applied reference shares the same reasons as applicant for using the said fluoroiodocarbons

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fire-extinguishing agents, as long as the reference either teaches or suggests that the selection of components will result in the disclosed effect (i.e. in the present case, fire-extinguishing), see In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990); In re Krong, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976), In re Linter, 485 F.2d 1013, 173 USPQ 560 (CCPA 1972); In re Gershon, 372 F.2d 535, 152 USPQ 602 (CCPA 1967); In re Mod, 161 USPQ 281 (CCPA 1969).

As shown above, the applied *Technical Report* provides more than sufficient motivation to form admixtures of known fire extinguishing agents. In fact, applicants preferred fluoroiodocarbon species and preferred perfluorocarbon species and preferred hydrofluorocarbon species are all individually, directly and specifically taught by The Technical Report as effective species for extinguishing fires, see Table I, pages 9-10, and Table II and Table VII. Furthermore, on pages 39-43 and 62, *The Technical Report* directly suggests the use of binary mixtures of halogenated carbons and halogenated hydrocarbons as fire extinguishing agents, and further suggests forming such binary mixtures to have a boiling point (i.e. azeotropic mixtures). Thus for the ordinary artisan to form mixtures of these said preferred halogenated species is just following what the disclosure would reasonable suggest to one having ordinary skill in the art. The Examiner's position is further supported by the courts which have constantly declared that to combined, even with a somewhat greater result, two or more materials in combination for the same purpose that they are taught as being individually useful is not patentable without a clear showing of superior and unobvious results, since it is

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logical that the materials would supplement each other, In re Kerhoven, 205 USPO 1069 (CCPA 1980), and In re Crockett et al. 126 USPO 186. Furthermore, it has often been held that it would have been *prima facie* obvious for the artisan of ordinary skill in the art to select components from among many disclosed by the prior art as long as it is taught or suggested that the selection will result in the disclosed effect (in the present case, fire-extinguishing), even when the possible selection numbers 1200 or greater, see Merck & Co., Inc. v. Biocraft Laboratories, Inc., 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989); In re Corkhill, 771 F.2d 1496, 226 USPQ 1005 (Fed. cir. 1985); In re Lemin, 332 F.2d 839, 141 USPQ 814 (CCPA 1964). Thus a *prima facie* case of obviousness has been established by the examiner.

Finally, applicants' have not rebutted the established *prima facie* case of obviousness since they have shown neither superior nor unexpected results for their particular claimed fire-extinguishing admixtures as compared to those admixtures directly taught by *The Technical Report*.

(14) Examiner's Answer, Conclusion

For the above reasons, it is believed that the rejection should be sustained.

Appel Conferees

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Respectfully submitted.

Joseph D. Anthony

Joseph D. Anthony
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Art Unit 1208

8/28/97